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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,734	01/23/2004	Robert J. Burnett	P1938US00	7329

24333 7590 10/28/2008

GATEWAY, INC.
ATTN: Patent Attorney
610 GATEWAY DRIVE
MAIL DROP Y-04
N. SIOUX CITY, SD 57049

EXAMINER	
PATEL, HETUL B	
ART UNIT	**PAPER NUMBER**
2186	

MAIL DATE	DELIVERY MODE
10/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/763,734	**Applicant(s)** BURNETT ET AL.	
	Examiner HETUL PATEL	**Art Unit** 2186	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Hetul Patel/
Patent Examiner
Art Unit: 2186

/Pierre-Michel Bataille/
Primary Examiner, Art Unit 2186

Continuation of 11. does NOT place the application in condition for allowance because:

As to the remark, Applicant asserted that:

(a) Claim 1 requires "receiving by the agent application on the at least one grid computer, from a local user of the at least one grid computer, designation of a minimum amount of disk storage space to be reserved on the disk drive of the at least one grid computer for local use by the local user". It is submitted that one of ordinary skill in the art would not understand the term "local user" to include the administrator of the grid system, as is contended in the above text and the rejection. It is submitted that the interpretation of "local user" as including the administrator of the grid system is not the "ordinary and customary meaning" that would be attributed to the term by one of ordinary skill in the art. Further, it is submitted that the written description of the patent application indicates the difference between a "local user" and the administrator (e.g., the "grid manager"), and one skilled in the art would appreciate this distinction.

(b) Neither the referenced portion nor the rest of the Talluri patent application discloses what entity sets the "storage policy". It is submitted that while cited paragraphs of Talluri discuss a storage policy in general, there is no indication of who sets the "storage policy" that is being discussed.

(c) The rejection States that "the admin/user of the storage system has to initially set the minimum amount/percentage described above in the storage policy" (emphasis added). Putting aside for the sake of discussion whether this is an accurate characterization of what is discussed in the Talluri patent application, the statement appears to admit that the "storage policy" is set by an administrator that is associated with the storage system of the Talluri system, and not "a local user of the at least one grid computer" as required by the claims. It is submitted that the rejection recognizes that the Talluri document does not disclose the requirements of the claims.

(d) The discussion in the Talluri patent application does not satisfy the requirements of an inherent disclosure as required by MPEP 2112. As noted previously, the discussion of the storage policy, and how it is set, is vague. Also, the statements in the rejection seem to imply that an administrator of the Talluri system sets the storage policy, and thus it is not set by the "local user of the at least one grid computer". It should be recognized that the language of the claim is very clear as to what qualifies as the local user, and this does not encompass the administrator of the Talluri system over the network system.

(e) The paragraph [0077] of the Ebstyne patent application does not discuss, and is not clear regarding, what entity controls the "client tier" on the enterprise personal computer. Claim 1 et al. requires that the designation come from "a local user of the at least one grid computer", and the Ebstyne patent application does not disclose this. One can speculate what entity reserves the configurable portion in Ebstyne, but that speculation is not sufficient to support a rejection. Merely because the client tier may reside on the enterprise personal computer does not disclose to one of ordinary skill in the art that a user of the enterprise personal computer is able to "reserve a configurable portion" of the disk space for the enterprise storage resource management system of Ebstyne. In fact, it is submitted that it would be counterintuitive for a. user of the enterprise personal computer to be able to set the operation parameters of the enterprise storage resource management system.

Examiner respectfully traverses Applicant's remark for the following reasons:

With respect to (a), (c) and (e), as clearly stated in the previous rejection, the minimum amount/percentage of unused storage space/capacity to be maintained/reserved on SG or at least one node is inherently defined/designed/set by the user in the storage policy. In other words, the admin/user of the storage system has to initially set the minimum amount/percentage described above in the storage policy. Further, Examiner considering the administrator as also a local user of the grid computer(s) as the administrator can also use the grid computer just as other local users. None of the pending claims' limitation(s) prevent from such an interpretation. Examiner would like to point out to Applicant that the initial burden of proof is shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103 (see MPEP 2184). Hence, Examiner respectfully maintains the inherency statement along with the prior rejection(s).

Furthermore, with respect to (e), the "client tier", which exist in each of the enterprise personal computers, has to be inherently set by the local user/admin of the enterprise personal computers so a portion of the available storage space get reserved. Since, in Ebstyne, each of the enterprise personal computer get a portion of the storage space reserved based on the "client tier" that inherently set by the local user/admin, the limitation "receiving a request from a local user for the minimum amount of storage space to be reserved on the grid computer for the local use" of claim 1 is considered taught by Ebstyne.

With respect to (b) and (d), Examiner agreed that the Talluri patent application failed to explicitly disclose about what entity sets the "storage policy", but it implicitly teaches about setting the "storage policy" by the user/admin because the admin/user of the storage system has to initially set the minimum amount/percentage described above in the storage policy so the minimum amount/percentage of unused storage space/capacity is maintained/reserved on SG or at least one node. Furthermore, with respect to (d), the language of the pending claim(s) is not clear as to what qualifies as the local user. Hence, as described above, the administrator can also be considered as a local user of the grid computer(s) since the administrator can also use the grid computer just as other local users.

/Pierre-Michel Bataille/
Primary Examiner, Art Unit 2186